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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Declan Patrick Kelly

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PHILIPS INTELLECTUAL PROPERTY & STANDARDS  
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EXAMINER

DANG, HUNG Q

ART UNIT

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/538,618	<b>Applicant(s)</b> KELLY, DECLAN PATRICK	
	<b>Examiner</b> Hung Q. Dang	<b>Art Unit</b> 2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2010.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 14-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 14-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>04/01/2010, 07/02/2010</u> .                                  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments filed 07/02/2010 have been fully considered but they are not persuasive.

On page 8, Applicant argues that the currently amended claim 7 overcomes 35 U.S.C. 112, second paragraph.

In response, Examiner respectfully disagrees since there is no "indication of user" recited in the claim and its basis claims. Thus, "said indication of user" renders the claim indefinite because it is not clear which indication it is referred to.

On pages 10-11, Applicant argues that Nielsen does not disclose or suggest the feature of "recording programs of at least a first type of programs on said storage medium of the recorder, wherein said first type of programs comprises programs explicitly subscribed to on a video-on-demand system by a user of the personal video recorder".

In response, Examiner respectfully disagrees. Nielsen discloses a system improved over existing systems that users explicitly subscribe to receive video on demand programs (*see at least column 1, lines 20-48*). As such, the programs to be recorded described therein comprise those are explicitly subscribed.

On pages 11-12, Applicant argues that, "there is no disclosure or suggestion [in Nielsen] of 'presenting the recorded programs in a summarized form in a User Interface.'"

In response, Examiner respectfully disagrees. The information presented to users as described in column 2, lines 41-52 is clearly a summarization of the recorded programs (e.g. at least information such as the number of events that exceed a set relevance level, the number of minutes of video exceeding a set relevance level is a summarized form of the recorded program). Further, at least in column 3, lines 4-19, Nielsen also teaches that the recorded programs are displayed in a highlight review mode in which not the whole programs are displayed but only portions selected based on a threshold relevance level are displayed. Clearly, as such, Nielsen does teach the feature of "presenting the recorded programs in a summarized form in a User Interface."

On pages 12-13, Applicant argues that, "there is no disclosure or suggestion [in Browne] of enabling a user to subscribe to a program for recording."

In response, Examiner respectfully disagrees and submits that when users select a program for recording, they are in fact explicitly subscribing the program for recording. Also, this is a video-on-demand system because users via selecting which programs to be recorded are requesting those programs on their demand. Applicant further argues that, "there is a distinction between the selection of a program and the subscription to a program" by citing some details from the specification. However, without admitting any deficiencies of Browne's teachings with respect to this matter, Examiner respectfully submits that at least those details are not recited in the claims thus irrelevant for the sake of arguments.

Applicant's arguments with respect to claim 2 on page 13 are therefore moot in view of the discussions above.

On pages 13-14, with respect to claim 3, Applicant argues that, "the display of Ali is of proposed or suggested program prior to the program having been recorded."

In response, Examiner respectfully disagrees. At least in [0090], Ali teaches that user rated-items and items with predicted ratings are both displayed, in which the user ratings are differentiated from predicted ratings through the user of distinct ratings icon. As such, user rated items are also displayed as shown in Fig. 2. Moreover, these user-rated items comprise recorded and/or watched programs as described at least in [0034].

On pages 14-15, Applicant argues that Li does not disclose the pay-per-view that is applied to recorded programs.

In response, Examiner respectfully submits that claim 9 only recites "the step of playing back a program" and not "the chosen program is played back on a pay-per-view basis". Thus, at least for that reason, the teachings of Li are correctly applied. Secondly, Li also discloses that such a summarization may be performed by the receiver (see at least [0079] and [0083]). As such, incorporating this feature into Nielsen would render the claim obvious.

Applicant's arguments on pages 15-16 with respect to claim 10 are moot in view of the discussions of at least Nielsen and Browne above.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Claim 7 recites, "said indication of the user". There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Nielsen et al. (EP 0 782 139 – hereinafter Nielsen).**

Regarding claim 1, Nielsen discloses a method of recording and playing back content to and from a personal video recorder for audio-visual content (*Fig. 1*), said personal video recorder having a storage medium for recording television programs (*column 1, line 50 – column 2, line 15; column 4, lines 32-49*), and for presenting information concerning the recorded content on said recorder (*column 1, line 50 – column 2, line 15; column 4, lines 50-56*), comprising the steps of: recording programs of at least a first type of programs on said storage medium of the recorder, wherein said first type of programs comprises programs explicitly subscribed to on a video-on-demand system by a user of the personal video recorder (*column 1, lines 20-53; column 4, lines 32-49*); presenting the recorded programs in a summarised form in a User

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Interface (*column 2, lines 41-52*); and playing back a program chosen by the user, wherein the chosen program is one of the above recorded programs of at least said first type of programs (*column 2, lines 41-52; column 4, lines 50-56*).

Claim 14 is rejected for the same reason as discussed in claim 1 above.

**Claim 11 is rejected under 35 U.S.C. 102(b) as being anticipated by Browne et al. (WO 92/22983 – hereinafter Browne).**

Regarding claim 11, Browne discloses a personal video recording system having a user interface, on which information is presented to a user, said user interface comprising a first user interface for explicitly subscribing to programs on a video-on-demand system for recording (*p.22—p. 24, line 12; Figs. 4-5; also see “Response to Arguments” above*), and a second user interface for presenting the recorded programs, wherein the recorded programs comprise at least said subscribed programs, whereby the user is given the opportunity to choose one of said recorded programs for viewing on a display screen (*p. 24, lines 18-24*) or to indicate disinterest in a recorded program (*p. 25, line 24 – p. 26, line 4*).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 2, 4-6, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nielsen as applied to claims 1 and 14 above, and further in view of Browne.**

Regarding claim 2, see the teachings of Nielsen as discussed in claim 1 above. However, Nielsen does not disclose wherein said step of recording programs further comprises the step of: said step of recording of a second type of programs on said storage medium of the recorder, wherein said second type of programs is on a user profile of said user.

Browne discloses recording of television programs comprises: recording a second type of programs on a storage medium of a personal video recorder, wherein said second type of programs is chosen automatically on a user profile of said user (*p. 12, line 8 –p. 13, line 26; p. 20, lines 17-27*).

One of ordinary skill in the art at the time the invention was made would have been motivated to incorporate the teachings of Browne into the method disclosed by Nielsen to enhance the user interface of the method by provide more options for users to select favorite programs for recording.

Regarding claim 4, Browne also discloses the step of deleting recorded programs when the user indicates that there is no interest in viewing a certain recorded program (*p. 19, lines 6-30; p. 25, line 24 – p. 26, line 4*).

Regarding claim 5, Browne also discloses the recorded programs are deleted after a certain amount of time (*p. 19, lines 6-30; p. 25, line 24 – p. 26, line 4*).



Regarding claim 6, Browne also discloses the certain amount of time is controlled by the size of available storage space on said storage medium (*p. 19, lines 6-30; p. 25, line 24 – p. 26, line 4*).

Claim 16 is rejected for the same reason as discussed in claim 2 above.

**Claims 3, 7-8, 15, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nielsen and Browne as applied to claims 1-2, 4-6, 11, 14, and 16 above, and further in view of Ali (US 2002/0199194 – hereinafter Ali).**

Regarding claim 3, see the teachings of Nielsen and Browne as discussed in claim 2 above. However, Nielsen and Browne do not disclose the step of presenting the recorded programs comprises indicating, on the user interface, which of the recorded programs are based on the user's subscription, based on the user's profile, or recommended by a broadcaster.

Ali discloses recording of a third type of programs on said storage medium of the recorder, wherein said third type of programs comprises programs recommended by a broadcaster ([0027]) and the step of presenting the recorded programs comprises the indicating, on a user interface, which of the recorded programs are based on the user's subscription, based on the user's profile, or recommended by a broadcaster (*Fig. 2; [0031]; [0090]; also see "Response to Arguments" above*).

One of ordinary skill in the art at the time the invention was made would have been motivated to incorporate the teachings of Ali into the method disclosed by Nielsen and Browne in order to further enhance the user interface of the method.

Regarding claim 7, Ali also discloses a step of updating user profile based on indication information (*Fig. 6; [0017]; [0031]*).

Regarding claim 8, Ali also discloses said user profile for recording of said second type of programs is adapted to the user, based on the type of subscribed programs (*Fig. 6; [0031]; [0054]; [0078]*).

Regarding claim 15, Ali also discloses recording of a third type of programs on a storage medium of the personal video recorder, wherein said third type of programs comprises programs recommended by a broadcaster (*[0027]*).

Claim 17 is rejected for the same reason as discussed in claim 15 above.

**Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nielsen and Browne as applied to claims 1-2, 4-6, 11, 14, and 16 above, and further in view of Li (US 2003/0081937 – hereinafter Li).**

Regarding claim 9, see the teachings of Nielsen as discussed in claim 1 above. However, Nielsen does not disclose the step of playing back a program is on a pay per view basis.

Li discloses a step of playing back a program is on a pay per view basis (*[0080]; also see "Response to Arguments" above*).

One of ordinary skill in the art at the time the invention was made would have been motivated to incorporate the teachings of Li into the method disclosed by Nielsen for economic reasons.

**Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nielsen, Browne and Ali as applied to claims 1-8, 11, and 14-17 above, and further in view of admitted prior art (hereinafter APA).**

Regarding claim 10, see the teachings of Nielsen, Browne, and Ali as discussed in claims 2 and 3 above. However, Nielsen, Browne, and Ali do not disclose a broadcaster pays per recording of said third type of programs.

APA discloses a broadcaster pays per recording of said third type of programs ([0005]).

One of ordinary skill in the art at the time the invention was made would have been motivated to incorporate the feature of a broadcaster paying per recording of said third type of programs for advertisement services (APA, [0005]).

### **Conclusion**

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hung Q. Dang whose telephone number is (571)270-1116. The examiner can normally be reached on IFT.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THAI Q. TRAN can be reached on 571-272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Hung Q Dang/  
Examiner, Art Unit 2621

/Thai Tran/  
Supervisory Patent Examiner, Art Unit 2621